

REMARKS

Claims 1-23, 37-39, and 46-59 are pending in the application and are presented here for examination. Claims 64 and 65 are newly added to the application as previously presented claims in independent form, and are presented here for examination. Claims 24-36, 40-45 and 60-63 have been withdrawn from consideration.

In the outstanding Office Action, the Examiner objected to the specification as failing to provide the proper antecedent basis for the claimed subject matter; rejected claims 1-10, 11, 17, 19-21, 23, 37, 38, 47, and 49-59 under 35 U.S.C. §112, second paragraph, as indefinite; rejected claims 1-5, 7-11, 16-18, 23, and 49-59 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,084,458 to Galley (hereinafter, "Galley"); rejected claims 46-48 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,474,489 to Vernon (hereinafter, "Vernon"); rejected claims 19-21 and 37-38 under 35 U.S.C. §103(a) as being unpatentable over Galley in view of U.S. Patent No. 4,619,082 to Dent (hereinafter, "Dent"); and indicated that claims 6, 12-15, 22, and 39 would be allowable if rewritten in independent form including the limitations of the base claims and any intervening claim(s).

By this Response and Amendment,

claims 1-3, 5, 7-11, 17, 20, 38, 46, 47, and 49-59 have been amended;
claims 6, 12, 13, 22, and 39 have been rewritten in independent form; and
claims 64 and 65 have been added as independent forms of formerly multiply-dependent claim 39

It is respectfully submitted that the following amendments introduce no new matter within the meaning of 35 U.S.C. § 132.

Applicants believe that the claim set, incorporating amended claims 1-3, 5-13, 17, 20, 22, 38, 39, 46, 47, and 49-59, original claims 4, 14-16, 18, 19, 21, 23, 37, and 48, and newly added claims 64 and 65, is in condition for allowance.

ALLOWABLE SUBJECT MATTER

It is indicated in the present Office Action that claims 6, 12-15, 22 and 39 would be allowable

if rewritten in independent form to include the features of the base claim and any intervening claims. This indication of allowable subject matter is noted with appreciation.

Claims 6, 12, 13, and 22 have accordingly been rewritten in independent form, and are asserted to now be in condition for allowance. Note that, due to a typographical error, claim 13 was submitted as dependent upon claim 9. Claim 13, like claim 12, was intended to depend on independent claim 11. Claim 13 has been rewritten in independent form to include the features of original claim 11, and is now asserted to be in condition for allowance. Claims 14 and 15 depend on allowable claims 13 and 12, respectively, and are asserted to be in condition for allowance. As claim 39 multiply depended on claims 17, 37 and 38, Applicant has amended claim 39 to place it in independent form and to include the features of base claim 17, and has also added new claims 64 and 65, which consist of original claim 39 rewritten in independent form to include the features of claims 37 and 38, respectively. As such, claims 39, 64, 65 are also asserted to be in condition for allowance.

Included with this response is a payment of the appropriate fees for claims 6, 12, 13, 22, 39, 64, and 65, which are now presented in independent form for the reasons above.

OBJECTIONS TO THE SPECIFICATION

In the outstanding Office Action, the Examiner objected to the specification for

- A1.** Failing to provide the proper antecedent basis for the claimed subject matter of “full-spatial mechanical and one optical true-position” in claims 19-21.
- A2** Failing to provide the proper antecedent basis for the claimed subject matter of “a priory integral chuck” in claims 51, 52, and 55.
- A3** Failing to provide the proper antecedent basis for the claimed subject matter of “being full register with one another.”

RESPONSE

A1 Claim 20 has been amended for clarity, and now recites a method “wherein the blocking chuck is formed with full-spatial mechanical datum indications and one optical true-position reference datum indication.” Support for this amendment in the specification can be found on page 4 of the specification, in paragraphs beginning on line 4 and line 16, and on page 5 of the specification, in the paragraph beginning on line 6.

Claim 21 depends on claim 20, now amended. Applicants respectfully note that claim 19 does not recite the feature of “full-spatial mechanical and one optical true-position,” and ask that the objection to claim 19 be withdrawn.

A2 Claims 51, 52 and 55 have been amended to remove all reference to an “a priory integral chuck,” and now refer to “at least the first chuck” as “integral with the lens blank.”

A3 Claim 49 has now been amended to recite, *inter alia*, “said first chuck being in full register with ~~one another~~the second chuck.”

As applicants assert that the claimed material now has the proper antecedent basis, applicants request that the Examiner withdraw all objections to the specification.

REJECTION UNDER 35 U.S.C. §112

In the outstanding Office Action, the Examiner rejected claims 1-10, 11, 17, 19-21, 23, 37, 38, 47, and 49-59 under 35 U.S.C. §112 as indefinite. Specifically, the Examiner rejected:

- B1** Claim 1 for failing to claim specific or positive steps.
- B2** Claims 1, 11, 17, 37, 38, and 47 for containing the word “then” instead of “than”
- B3** Claim 49 for the unclear terminology “being in full register with one another.”
- B4** Claims 51-53 and 55 for the unclear term “a-priory integral chuck.”
- B5** Claim 13 for lacking an antecedent basis for the feature “the structural support material.”

RESPONSE

B1 By this response and amendment, claim 1 has been amended to recite “[a] method for processing a lens blank provided with a first surface and a second surface to be processed by a processing equipment for imparting the first and the second surface with required surface topography and obtaining a corresponding first optical face and a second optical face of a lens, said method comprises positioning the lens blank in a gripping device and gripping the lens blank by a gripping device while relying on reference datum indications enabling orientation of the lens blank to obtain the required surface topography of both optical faces of the lens, and wherein not more than one reference

datum indication extends on the first optical face of the lens.”

Applicants assert that the new wording now recites the specific steps of the claimed method without introducing any new patentable matter. Claims 11, 17, 37, 38, and 57 have been similarly amended to recite the steps of the claimed methods in similar language. Applicants respectfully note that the Examiner has not specified the exact nature of the rejections to claims 57-59. Applicants assert that these claims, as amended, are in condition for allowance.

B2 By this response and amendment, claims 1, 11, 17, 37, 38, and 47 have been amended to correct this typographical error.

B3 By this response and amendment, claim 49 has been amended and now recites, *inter alia*, “a first chuck associated with the first optical face of the lens” and “a second chuck associated with the second optical face of the lens” with “said first chuck being in full register with ~~one another~~ the second chuck.” Applicants assert that the terminology of this claim feature is now sufficiently clear.

B4 By this response and amendment, claims 51-53 now recite that the first chuck is “integral with the lens blank.” Claim 55 now discloses “a lens blank with an integral chuck extending at a first face thereof.” Applicants assert that the terminology of this claim feature is now sufficiently clear.

B5 Because of a typographical error, Claim 13 was submitted as depending on claim 9. Claim 13 was intended to depend on claim 11, which provides sufficient antecedent basis for this feature, as it did for the same term as used in allowable claim 15. Claim 13 has by way of this response been amended to include all of the features of original claim 11. As such, applicants assert that the terminology of this claim feature is now sufficiently clear, and that proper antecedent basis has been provided.

As Applicants assert that the above amendments address all of the examiner’s cause for rejection under 35 U.S.C. §112, Applicants request that the Examiner withdraw all such rejections to these claims.

REJECTION UNDER 35 U.S.C. §102(b)

In the outstanding Office Action:

C1 Independent claims 1, 11, and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by Galley.

C2 Claims 2-5 and 7-10 were rejected as being dependent upon rejected claim 1; claim 16 was rejected as being dependent on rejected claim 11; and claims 18 and 23 were rejected as being dependent on rejected claim 17.

C3 Independent claims 49, 55, and 57 were rejected under 35 U.S.C. §102(b) as being anticipated by Galley.

C4 Claims 50-54 were rejected as being dependent on rejected claim 49; claim 56 was rejected as being dependent on rejected claim 55; and claims 58-59 were rejected as being dependent on rejected claim 57.

C5 Independent claims 46-48 were rejected under 35 U.S.C. §102(b) as being anticipated by Vernon.

RESPONSE

Reconsideration and withdrawal of the rejections are respectfully requested.

C1 By this Response and Amendment, the rejection to claim 1 is respectfully traversed since all of the features of independent claim 1 are not disclosed, taught or suggested in the cited prior art.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Claim 1 has been amended, and now recites “A method for *processing a lens blank provided with a first surface and a second surface* to be processed by a processing equipment for imparting the first and the second surface with required surface topography

and obtaining a corresponding first optical face and a second optical face of a lens, said method comprises positioning the lens blank in a gripping device and gripping the lens blank by a gripping device while *relying on reference datum indications enabling orientation of the lens blank to obtain the required surface topography of both optical faces of the lens*, and wherein *not more than one reference datum indication extends on the first optical face of the lens.*" (Present application, claim 1, emphasis added).

Galley teaches a method of manufacturing a contact lens, and is drawn in contrast to the steps of obtaining a lens blank with one circular surface initially available for machining, mounting the lens blank to a support, processing a first optical face of the lens from said one surface, and then turning over the lens blank, mounting it to a second support, and machining the second optical face. (Galley, column 1, line 64, to column 3, line 50).

Galley fails to disclose, teach, or suggest the claim feature of "processing of a lens blank provided with a first and a second surface" in which the lens blank is gripped "while relying on reference datum indications enabling orientation of the lens blank to obtain the required surface topography of both optical faces of the lens." (present application, claim 1).

In Galley, only one surface is initially available for machining. This surface is pre-molded dished end 13. "The lens blank 10 is mounted to a rotatable support 11" (Column 1, lines 66-67). "The blank 10 is preferably in the form of a right circular cylinder with a pre-moulded dished end 13." (Column 2, lines 4-6) After completing machining of the dished end and obtaining the first optical face (concave surface 90) the lens blank is moved from the support 11 and re-positioned the other way round with machined concave surface 90 stuck to a second support 61. "[A]n edge forming tool 30 machines the desired circumferential edge surface 92 on the rotating supported blank 10" (Column 2, lines 27-29). "[T]he polished partly-worked blank...is moved from its support 11 and re-positioned the other way round with the machined concave surface 90 stuck...to a second support 61." (Column 3, lines 5-9). Only then is the cylindrical surface adjacent the opposite end of the lens blank machined away so as to obtain second optical face 93.

In Claim 1 of the present invention, both faces are provided initially as part of the

lens blank (see Claim 1: “processing of a lens blank provided with a first and a second surface”). The second optical face is obtained not by machining away a right circular cylinder, but by machining the opposite end itself. See Specification, page 9, paragraph beginning on line 19: “lens blank 10...is a highly translucent cylindrical body having a first face 12, and second face 14 and a peripheral portion...” See also the embodiment of Fig. 1C, as detailed in the specification, page 10, line 17 in which “the first and second faces 62 and 64, respectively may be already complete as far as their optical topography, or may be near to complete or only partially formed.”

Furthermore, Galley fails to disclose, teach, or suggest that “*not more than one reference datum indication extends on the first optical face of the lens.*” In contrast, Galley teaches that the positioning of the lens blank with respect to support 61 is carried out while relying on the crown 63 of the concavity through the body of the material perpendicular to the lens axis as shown by vision line 64 (column 3, lines 10-12). In other words the reference datum indication, which is used for positioning the lens blank, is the Crown Point on the first optical face. This datum indication does not extend on the first optical face. In the present invention one of the reference datum indications associated with the first optical face is axial recess 90, which extends on the optical face.

Independent claims 1, 11, and 17 are by this response and amendment amended to emphasize the difference between the present invention and Galley. As Galley fails to disclose, teach, or suggest all of the claimed features as amended, applicants respectfully request that the Examiner reconsider and withdraw the rejections to claims 1, 11, and 17 under 35 U.S.C. 102(b).

C2 As applicants assert that claim 1 is not anticipated by Galley, applicants respectfully request that the Examiner reconsider and withdraw the rejections to claims 2-5 and 7-10 as amended, which depend on claim 1.

As applicants assert that claim 11 is not anticipated by Galley, applicants respectfully request that the Examiner reconsider and withdraw the rejection to claim 16, which depends on claim 11.

As applicants assert that claim 17 is now in condition for allowance, applicants respectfully request that the Examiner reconsider and withdraw the rejections to claims 18

and 23, which depends on claim 17.

C3 By this Response and Amendment, the rejections to claims 49, 55, and 57 are respectfully traversed since all of the features of these independent claims as amended are not disclosed, taught or suggested in the cited prior art.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Claims 49, 55, and 57 recite methods for processing a first optical face and a second optical face of a lens. The method of claim 49 contains, *inter alia*, “a first chuck associated with the first optical face of the lens and...a second chuck associated with the second optical face of the lens.” The method of claim 55 contains “a lens blank with an integral chuck extending at a first face thereof” and “attaching an additional chuck to said full face” before “gripping the blank at said additional chuck and machining away the integral chuck and processing the second face of the lens.” The method of claim 57 includes the steps of “attaching a first chuck to the second surface of the blank” and “blocking a second chuck to the first optical face of the lens.”

The manufacture process of Galley, as described above, teaches a method of manufacturing a contact lens, and is drawn in contrast to the steps of mounting the lens blank to a support, processing a first optical face of the lens from said one surface, and then turning over the lens blank, mounting it to a second support, and machining the second optical face. (Galley, column 1, line 64, to column 3, line 50).

Galley fails to disclose, teach, or suggest using a first and second chuck associated with corresponding first and second faces of the lens blank. Rather, Galley teaches that a *rotatable support* is placed in a single chuck. See Galley, column 1, line 66, where “the blank is mounted to a rotatable support” and “the support 11 is adapted for reception in a chuck or the like of a material removal machine such as a lens lathe.” As Galley does not

teach using both a first and a second chuck associated with the first and second faces of the lens blank, Galley cannot anticipate claims 49, 55, and 57 of the present invention.

Moreover, as argued above, Galley fails to disclose, teach, or suggest the claim feature of “a lens blank having a first surface and a second surface [for] obtaining a corresponding first optical face and second optical face of a lens.” (Present application, claim 57). Therefore, for the same reasons argued in point C1 above, Galley cannot anticipate claim 57 of the present application.

Independent claims 49, 55, and 57 are by this response and amendment amended to emphasize the difference between the present invention and Galley. As Galley fails to disclose, teach, or suggest all of the claimed features as amended, applicants respectfully request that the Examiner reconsider and withdraw the rejections to claims 49, 55, and 57 under 35 U.S.C. 102(b).

C4 As applicants assert that claim 49 is not anticipated by Galley, applicants respectfully request that the Examiner reconsider and withdraw the rejections to claims 50-54, which depend on claim 49.

As applicants assert that claim 55 is not anticipated by Galley, applicants respectfully request that the Examiner reconsider and withdraw the rejection to claim 56, which depends on claim 55.

As applicants assert that claim 57 is not anticipated by Galley, applicants respectfully request that the Examiner reconsider and withdraw the rejections to claims 58 and 59, which depends on claim 57.

C5 By this Response and Amendment, the rejections to claims 46-48 are respectfully traversed since all of the features of each of these independent claims are not disclosed, taught or suggested in the cited prior art.

For a reference to anticipate an invention, all of the elements of that invention must be present in the reference. The test for anticipation under section 102 is whether each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131. The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d

1913, 1920 (Fed. Cir. 1989); MPEP §2131.

Claim 46, as amended, recites “[a] method for processing optical faces of a lens in a lens processing machine wherein processing optical faces of the lens is carried out while *a lens blank is gripped in a chuck of the lens processing machine* at peripheral surfaces of the lens blank” (Present application, claim 46, emphasis added). Similarly, claim 47 teaches “gripping a lens blank during processing optical faces of the lens,” and claim 48 teaches a method in which “a lens blank is directly gripped.”

Vernon teaches a base lens blocking system in which a lens blank is blocked to a block 204 and the block is held by a drawback collet 232 in the nose 234 of a lathe spindle 236. (See Vernon, Claim 1, “a recessed collet for carrying a lens blank”; Vernon, specification, column 6, lines 11-13).

Vernon does not disclose, teach, or suggest that “a lens blank is gripped in a chuck of [a] lens processing machine.” Further, Vernon does not teach “gripping a lens blank” at all. Rather, the method of Vernon involves “mounting [a] lens blank to a block” (Vernon, Summary of the Invention, Column 1, lines 66-67), specifically to “avoid the distortion produced by having the lens blank [directly placed] in a collet,” or, presumably, in a chuck. (Vernon, Background of the Invention, Column 1, lines 35-36). Vernon cannot anticipate claims 46-48, as it lacks any form of “gripping a lens blank” and instead relies solely on blocking a lens blank.

For the above reason, Applicants respectfully request reconsideration and withdrawal of the rejection.

As Applicants assert that the above amendments address all of the examiner’s cause for rejection under 35 U.S.C. §102(b), Applicants request that the Examiner withdraw all such rejections to these claims.

REJECTION UNDER 35 U.S.C. §103(a)

In the outstanding Office Action:

D1 Dependent claims 19-21, and independent claims 37 and 38, were rejected under 35 U.S.C. §103(a) as being unpatentable Galley.

RESPONSE

Reconsideration and withdrawal of the rejections are respectfully requested.

D1 By this Response and Amendment, the rejections to claims 19-21 are respectfully traversed since not all of the features of these claims are disclosed, taught or suggested in the combination of cited prior art, and since their combination fails to provide a reasonable expectation of success.

To establish a *prima facie* case of obviousness, the Examiner must establish: (1) some suggestion or motivation to modify the references exists; (2) a reasonable expectation of success; and (3) the prior art references teach or suggest all of the claim limitations. *Amgen, Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991); *In re Fine*, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

Claim 19 recites a method for processing optical faces of a lens “wherein the blocking chuck is a mobile device *pre-formed with full-spatial mechanical true-position reference datum indications*.” Claim 20 recites a method “wherein *the blocking chuck is formed with full-spatial datum indications and one optical true-position reference datum indication*.” Claim 21 recites a method as in claim 20 “wherein orientation of the blocking church with reference to the lens blank is based on *a combination of mechanical and optical reference datum indications*.” (emphases added)

Claims 19-21 all depend on claim 17, which recites “[a] method for processing optical faces of a lens” comprising, *inter alia*, the steps of “[p]roviding a lens blank having a first surface and a second surface” and “processing the lens blank to obtain full-spatial reference datum indications and processing the first optical face of the lens whereby said reference datum indications define the coordinates of the lens with respect to the first optical face; and wherein *not more than one reference datum indication extends on the first optical face of the lens*” (emphases added)

Claims 37 and 38 recite “[a] method for processing optical faces of a lens” comprising, *inter alia*, the steps of “obtaining a lens blank *pre-formed with reference datum indications*” and “processing the lens blank relying on said reference datum indications;

wherein not more than one reference datum indication extends on an optical surface of the lens” (emphases added).

Dent teaches a method for contact lens manufacture “involving machining a first face (2,3) and a reference surface (4) on a blank (1); mounting the blank (1) in a work holder (10) adapted for accurate mounting on a lathe such that the blank (1) is held with its first face (2,3) accurately positions relative to a datum point on the lathe; and machining a second face (8) on the blank (1).”

Dent fails to cure the deficiencies of Galley already mentioned above in discussing claim 17. Specifically, Galley fails to disclose, teach, or suggest that “not more than one reference datum indication extends on the first optical face of the lens” (present application, claims 17, 37, 38). As discussed above, Galley teaches that the positioning of the lens blank with respect to support 61 is carried out while relying on the crown 63 of the concavity through the body of the material perpendicular to the lens axis as shown by vision line 64 (column 3, lines 10-12). In other words the reference datum indication, which is used for positioning the lens blank, is the Crown Point on the first optical face.

Dent, like Galley, fails to disclose, teach, or suggest that “not more than one reference datum indication extends on the first optical face of the lens.” The reference datum indication in Dent’s method is pre-formed reference surface 4, which does not belong to the first optical face. This reference surface is located outside the first optical face.

Therefore, the combination of Galley and Dent fails to disclose, teach, or suggest a reference datum indication which extends on the first optical face of the lens. As the combination of Dent and Galley fails to teach or suggest all of the claim features of claim 17, on which claims 19, 20, and 21 depend, applicants assert that they are now in condition for allowance. Further, as the combination of Dent and Galley fails to teach or suggest all of the claim features of claims 37 and 38, applicants assert that they are now in condition for allowance.

Also, applicants argue that one would not be motivated to combine Galley and Dent to produce the methods of claims 19-21, 37, and 38, and that any combination thereof would not yield success. Neither Galley, nor Dent contains any implicit or explicit teaching, suggestion, or incentive to combine these references. Furthermore, Galley contains no

teaching regarding the desirability of forming reference datum indications before processing the lens. As mentioned before, Galley teaches to use the Crown Point for positioning the lens blank. This Crown Point is obtained after completing the machining of the first optical face. In other words, applicants respectfully assert that the reference datum indication employed by Galley is not provided before processing of the lens face (as alleged by the Examiner), but after processing of the lens face.

As mentioned above, Galley teaches to use the reference datum indication, which belongs to the processed first optical face. Dent employs as reference datum indication pre-formed reference surface 4, which does not belong to the first optical face. This reference surface is located outside the first optical face. Therefore, the alleged combination of Dent with Galley would not bring the desired result of "forming reference datum indications before processing the lens," since the reference datum indication of Dent is not suitable for Galley.

Thus, as neither Galley nor Dent contains any implicit or explicit teaching, suggestion, or incentive to combine these references to produce the claim features of claims 17 (on which claims 19, 20, and 21 depend), 37, or 38, reconsideration and withdrawal of the rejection of claims 19-21, 37, and 38 under §103(a) is requested.

CLAIMS ADDED BY AMENDMENT

In the outstanding office action, the Examiner stated that claim 39 would be allowable if rewritten in independent form including all the features of the base claim and any intervening claims. As claim 39 depended multiply on claims 17, 37, and 38, it has been rewritten in three independent forms. The first of these forms includes the features of claim 17, and replaces original claim 39 by way of this amendment. The second of these forms includes the features of claim 37, and is hereby entered as new claim 64. The third of these forms includes the features of claim 38, and is hereby entered as new claim 65.

As new claims 64 and 65 contain only subject matter that the Examiner has previously stated is in condition for allowance, applicants kindly request that the new claims be entered and allowed.

CONCLUSION

In light of the foregoing, Applicants submit that the application is now in condition for allowance. If the Examiner believes the application is not in condition for allowance, Applicants respectfully request that the Examiner contact the undersigned attorney if it is believed that such contact will expedite the prosecution of the application.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

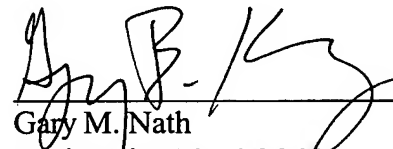
Respectfully submitted,

NATH & ASSOCIATES PLLC

Date: DECEMBER 30, 2005
NATH & ASSOCIATES PLLC
112 South West Street
Alexandria, VA 22314

(703) 548-6284

By:



Gary M. Nath
Registration No. 26,965
Gregory B. Kang
Registration No. 45,273
Customer No. 20529